UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/919,162	07/31/2001	Jean-Christophe Renauld	LUD 5684.2 CIP (10106926)	3161

7590 07/12/2004

Fulbright & Jaworski LLP
666 Fifth Avenue
New York, NY 10103

EXAMINER	
JIANG, DONG	

ART UNIT	PAPER NUMBER
1646	

DATE MAILED: 07/12/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/919,162	RENAULD ET AL.	
	Examiner	Art Unit	
	Dong Jiang	1646	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *10 October 2001*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-30* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☐ Claim(s) _____ is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☒ Claim(s) *1-30* are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Applicant's preliminary amendment filed on 10 October 2001 is acknowledged and entered. Following the amendment, claims 1, 24 and 26 are amended.

Currently, claims 1-30 are pending.

Election/Restrictions

Restriction to one of the following inventions is required under 35 U.S.C. 121:

I. Claims 1-12, 17 and 18, drawn to an isolated nucleic acid, a vector containing the nucleic acid, a host cell thereof, and a method of recombinantly producing the encoded polypeptide, classified in class 435, subclass 69.1.

II. Claims 13, 14, 19, 20, 28 and 29, drawn to an isolated protein, classified in class 530, subclass 350.

III. Claim 15, 16 and 30, drawn to a method for inhibiting effect/binding of IL-TIF/IL-22, and a method for determining the presence of IL-TIF/IL-22 using the protein, classified in class 435, subclass 7.1.

IV. Claims 21-23, drawn to an isolated antibody and a hybridoma producing same, classified in class 530, subclass 388.1.

V. Claims 24 and 25, drawn to a method for determining the presence of said protein in a sample using the antibody, classified in class 435, subclass 7.1.

VI. Claim 26 and 27, drawn to an isolated oligonucleotide, and a method for determining expression of a nucleic acid in a sample by hybridization using said oligonucleotide, classified in class 435, subclass 7.1.

The inventions are distinct, each from the other because:

The nucleic acid of Invention I is related to the protein of Invention II by virtue of encoding same. The nucleic acid molecule has utility for the recombinant production of the protein in a host cell. Although the nucleic acid molecules and proteins are related since the nucleic acid encodes the specifically claimed protein, they are distinct inventions because they are physically and functionally distinct chemical entities, and the protein product can be made by

another and materially different process, such as by synthetic peptide synthesis or purification from the natural source. Further, the nucleic acid may be used for processes other than the production of the protein, such as nucleic acid hybridization assay.

The method of Invention I is related to the protein of Invention II as process of making and product made. The Inventions are distinct if either or both of the following can be shown: (1) that the process as claimed can be used to make other and materially different product or (2) that the product as claimed can be made by another and materially different process (MPEP 806.05(f)). In the instant case the product as claimed may be isolated from their natural source or made by chemical peptide synthesis.

Invention I is distinct from and unrelated to Inventions III and V, wherein the nucleic acid of Invention I is neither made by nor used in the methods of Inventions III and V, and wherein each does not require the other.

The nucleic acid of Invention I is distinct from and unrelated to the antibody of Invention IV because they are physically and functionally distinct chemical entities which share neither structure nor function. Also, neither is required for the manufacture of the other. The method of Invention I is distinct from and unrelated to the antibody of Invention IV because the antibody may be neither made by nor used in the method.

Although the nucleic acid of Invention I and the oligonucleotide of Invention VI are related since the oligonucleotide is a part of the nucleic acid of Invention I, they are distinct Inventions because they have distinct structures, and are used for different purposes, and thus, they require separate searches.

Invention II is related to Invention III as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case the product as claimed may be used for the generation of the antibody of Invention IV.

The protein of Invention II is related to the antibody of Invention IV by virtue of being the cognate antigen, necessary for the production of the antibodies. Although the protein and antibody are related due to the necessary stearic complementarity of the two, they are distinct

inventions because they are physically and functionally distinct chemical entities, and because the protein can be used another and materially different process from the use for production of the antibody, such as in a pharmaceutical composition in its own right, or in assays for the identification of agonists or antagonists of the protein.

Invention II is distinct from and unrelated to Inventions V and VI, wherein the protein of Invention II is neither made by nor used in the methods of Inventions V and VI, and wherein each does not require the other.

Inventions III, V and VI are drawn to independent methods, wherein each of the methods has different process steps, different active agents, different starting and ending points, and is for a different purpose, such that they require separate searches.

Invention III is distinct from and unrelated to Invention IV, wherein the antibody of Invention IV is neither made by nor used in the methods of Invention III, and wherein each does not require the other.

Invention IV is related to Invention V as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case the product as claimed may be used for the purification of the protein of Invention II.

Invention IV is distinct from and unrelated to Invention VI, wherein the antibody of Invention IV is neither made by nor used in the methods of Invention VI, and wherein each does not require the other.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification and/or recognized divergent subject matters, restriction for examination purposes as indicated is proper.

2. Furthermore, regardless of which Invention applicants elect above, further **restriction** is required under 35 U.S.C. 121:

A. One specific amino acid sequence with SEQ ID NO:, i.e. SEQ ID NO:6 or 11.

The inventions are distinct, each from the other because of the following reasons:

Although there are no provisions under the section for "Relationship of Inventions" in M.P.E.P. § 806.05 for inventive groups that are directed to *different* products, restriction is deemed to be proper because these products constitute patentably distinct inventions for the following reasons. Each of SEQ ID NOs is a unique and separately patentable sequence, requiring a unique search of the prior art. Searching all of the sequences in a single patent application would constitute an undue search burden on the examiner and the USPTO's resources because of the non-coextensive nature of these searches.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

In order to be fully responsive, Applicant must elect one from Groups I-VI, one from Group A, even though the requirement is traversed. Applicant is advised that neither I-VI nor A are species election requirements; rather, each of I-VI and A is a restriction requirement.

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a petition under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Advisory Information

Any inquiry concerning this communication should be directed to Dong Jiang whose telephone number is 571-272-0872. The examiner can normally be reached on Monday - Friday from 9:30 AM to 7:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Brenda Brumback, can be reached on 571-272-0961. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

LORRAINE SPECTOR
PRIMARY EXAMINER

Dong Jiang, Ph.D.
Patent Examiner
AU1646
7/7/04